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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

DEXTER, C

ART UNIT

PAPER NUMBER

3724

13

DATE MAILED:

10/23/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/926,819

Applicant(s)
Tseng

Examiner
Clark F. Dexter

Group Art Unit
3724



☒ Responsive to communication(s) filed on Aug 7, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 20-41 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 20-26, 38, and 39 is/are allowed.

☒ Claim(s) 27-37, 40, and 41 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. The amendment filed August 7, 2000 has been entered. Upon careful reconsideration, the indicated allowability of claim 31 is withdrawn in view of the references to Rogers et al. (pn 5,113,585) and Creasy et al. Further, additional rejections have been made which were not necessitated by applicant's amendment and, accordingly, this Office action is being made **non-final**.

Claim Rejections - 35 USC § 112

2. Claims 27, 30 and 32-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 27^X, line 2, "sized and adapted for attachment" is vague and indefinite as to how the skin engaging member is "sized" and "adapted" to perform the recited function.

In claim 30^Y, line 2, "adapted to change color" is vague and indefinite as to how the skin engaging member is "adapted", and further the limitation is vague and indefinite since there is not sufficient structure set forth to perform the claimed function.

In claim 32, lines 11-12[/], the phrase "adapted to be immovably affixed to said razor cartridge and to erode" is vague and indefinite as to what is being set forth, particularly as to how the skin engaging layer is "adapted" to perform the recited function.

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Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 27^x is rejected under 35 U.S.C. 102(b) as being anticipated by Wolf.

Wolf discloses a member (e.g., in Figs V-VII) with every structural limitation of the claimed invention including a means indicating a change in the amount of shaving aid (e.g., the flexibility of the material which permits squeezing of the device; or openings in the mesh material which permit visual inspection; etc).

5. Claims 27, 28^x, 40 and 41/40 are rejected under 35 U.S.C. 102(b) as being anticipated by Rogers, pn 5,113,585 (hereafter Rogers '585).

Rogers '585 discloses a skin engaging member (e.g., 42, 64) with every structural limitation of the claimed invention including a water insoluble polymer, an amount of water soluble shaving aid, and means (e.g., the surface of the strip or the color dye) for gradually indicating a change in the amount of shaving aid; that is, as the skin engaging member is used, the surface of the strip will become worn and show signs of wear thus indicating a change in the amount of shaving aid; and/or the color dye will bleed out of the strip along with the shaving aid thus indicating as the color fades a change in the amount of shaving aid.

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Claim Rejections - 35 USC § 102/103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 28-30^x are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wolf.

Wolf discloses a member with every structural limitation of the claimed invention including at least one coloring agent (e.g., the color of the shaving soap). In the alternative, if it is argued that there is no disclosure of the shaving soap having a color, the Examiner takes Official notice that it would have been obvious to one having ordinary skill in the art to use a colored soap with the device of Wolf for various well known reasons including providing a visible indication on the outside of the device that soap is present.

Claim Rejections - 35 USC § 103

8. Claims 29-31^x and 41/31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rogers '585 in view of Creasy et al.

Rogers '585 discloses a blade but lacks the skin engaging member comprising at least two layers including at least one non-skin engaging layer. However, Creasy et al. discloses that it is known in the art to provide a non-skin engaging layer of adhesive to attach the skin engaging

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layer to the razor cartridge. Therefore, it would have been obvious to one having ordinary skill in the art to provide a non-skin engaging layer for the benefits taught by Creasy et al.

Allowable Subject Matter

9. Claims 32-37 appear that they would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action.

10. Claims 20-26^x, 38, 39 and 41/39 are allowable over the prior art of record.

Response to Arguments

11. Applicant's arguments filed August 7, 2000 have been fully considered but they are not persuasive.

First, applicant's attention to the missing dates on the IDS (paper #8) is appreciated. Since applicant does not know the exact dates, these items will simply be marked "(date unknown)" on the IDS.

35 USC 112 Rejections:

In the paragraph at the bottom of page 6 of the amendment directed to the rejections under 35 USC 112, applicant argues that the use of "adapted to" language is not improper. Specifically, applicant argues that "[I]t is well established that limitations appearing in "adapted to" clauses and functional terms, such as erodible, give meaning to the structure." However, the

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Examiner's position is not that the "adapted to" language is improper. Rather, the Examiner's position is that the "adapted to" clauses in the subject claims are vague and indefinite since it is not clear how the particular feature is "adapted" to perform its respective function. More specifically, in claim 27, it is not clear how the skin engaging member is "sized" for attachment to a razor, and further it is not clear how the skin engaging member is "adapted" for attachment to a razor; similarly, in claim 30, it is not clear how the skin engaging member is "adapted to change color", specifically since no structure is set forth to perform such a function (i.e., there is no structure set forth to which the "adapted to" clause can give meaning); similarly, in claim 32, it is not clear how the skin engaging layer is "adapted to be immovably affixed", specifically since no structure is set forth to perform such a function (i.e., there is no structure set forth to which the "adapted to" clause can give meaning).

Prior Art Rejections:

In the second paragraph on page 5 of the amendment, applicant argues that "there is nothing in the sack that gradually indicates a change in the amount of soap in the sack." The Examiner respectfully submits that the sack includes various means such as the flexibility of the material which permits squeezing of the device; or openings in the mesh material which permit visual inspection for gradually indicating a change in the amount soap in the sack.

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Potential Interference:

Applicant's request for an investigation of a potential interference between the present application and application sn 08/285,364 to Wexler et al. is noted.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703)308-2187.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3579; informal/draft papers - (703)305-9835.



Clark F. Dexter
Primary Examiner
Art Unit 3724

cfd
October 19, 2000